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Paper No. 8

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OFFICE OF PETITIONS

In re Application of
Hania et al..
Application No. 10/045,651
Filed: November 7, 2001
Attorney Docket No. 501010-20522

DECISION ON PETITION

This is a decision on the renewed petition filed October 15, 2002, requesting, in effect, that page 24 of the specification filed on May 30, 2002, be entered as part of the original disclosure.

The petition is **dismissed**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are NOT permitted. This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The application was filed on November 7, 2001. On April 8, 2002, the Office of Initial Patent Examination mailed a "Notice of Omitted Item(s)" stating that the application had been accorded a filing date of November 7, 2001, and advising applicants that page 24 of the specification appeared to have been omitted.

In response, petitioner alleges page 24 of the specification was filed with the original application.

The evidence supplied by petitioner includes a non-itemized postcard receipt, a copy of the transmittal letter, and a declaration by the attorney.

The postcard:

The last portion of MPEP 513 states,

Where there is a dispute as to the contents of correspondence submitted to the Office (e.g., an applicant asserts that three sheets of drawings were submitted under 37 CFR 1.10 with an application, but the Office records indicate receipt of only two sheets of drawings with the application) ... The Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g. a postcard receipt

MPEP 503 states (emphasis added),

The identifying data on the postcard should include:

- (A) applicant's name(s);
- (B) title of invention;
- (C) **number of pages of specification, claims (for nonprovisional applications),**

- and sheets of drawing;**
- (D) whether oath or declaration is included;
 - (E) a list of any additional forms included with the application (e.g., application transmittal form, application data sheet, fee transmittal form, and /or provisional application cover sheet); and
 - (F) amount and manner of paying the fee.

A return postcard should be attached to each patent application for which a receipt is desired.

It is important that the return postcard itemize all of the components of the application. **If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO).** . . .

A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. **The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted.** If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., **the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).**

The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

A postcard receipt is prima facie evidence because, upon receipt of the application, a disinterested individual compares the postcard receipt to the contents of the application. The individual ensures each item listed on the postcard is present and then the postcard is returned to applicant. If the postcard lists "Specification," the individual will review the application to see if a specification is present. The individual will not count the number of pages of specification or read the specification to see if pages may be missing. If the postcard lists "10 pages of specification," then the individual will review the application to see if 10 pages of specification are present. Petitioner's postcard only proves that the individual who reviewed the application and postcard verified that a specification was present. The Office does not dispute that a specification was filed on November 7, 2001, and if such a dispute arose, the postcard receipt would serve as prima facie evidence that something purporting to be a specification was filed on November 7, 2001. The Office disputes the number of pages of specification filed. Since the individual who mailed the postcard back to applicant did not count the number of pages of

specification, the receipt of the return postcard cannot serve as evidence that page 24 was present upon filing.

The transmittal sheet:

Assuming the transmittal sheet was proofread before it was signed, the transmittal sheet establishes that petitioner intended to file the number of pages listed on the sheet and that petitioner believed such pages would be filed. However, the transmittal form does not prove the page 24 was actually filed. The transmittal paper only proves that the page was not intentionally omitted, but does not prove the paper might not have been inadvertently omitted.

The declaration:

Petitioner raises the issue as to the extent to which declarations should be accepted to establish a filing date for an application or portions of an application. The Commissioner has refused to accept mere declarations in order to prove the filing date of an application.¹ The contents of an application are just as critical as the filing date for an application. Regarding the filing date issue, the Office expressly rejected reliance solely on evidence from an applicant when the Office rejected the use of 37 CFR 1.8 for purposes of obtaining a filing date.² 37 CFR 1.8 provides a

¹ *Federal Register* at 48 *Fed. Reg.* 2696 (January 20, 1983), and in the Patent and Trademark Office *Official Gazette* at 1027 *Off. Gaz. Pat. Office* 9 (February 1, 1983) ("Comment: One person commented that he found the idea of using a declaration or affidavit to establish a date of deposit unacceptable because it exposes the integrity of the assignment of filing dates to the risk of deception. Reply: The use of declarations or affidavits is usually intended to help explain activities which can be supported by exhibits. For example, if the Office copy of the mailing label was not entirely readable, applicant's copy of the "Express Mail" mailing label could accompany a declaration and serve as the basis for granting a filing date.")

Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) ("Plaintiff thereafter submitted three affidavits, a declaration, and copies of two pages of records from his attorney's law firm, but the Commissioner finally denied plaintiff's petition for a filing date on the grounds that, if plaintiff had used Express Mail properly, he would have had an Express Mail receipt showing the actual date of mailing; and that the materials later submitted by the plaintiff were not good enough proof.

The materials plaintiff gathered together included a photocopy copy of an Express Mail label that is undated and bears no evidence of any U.S. Postal Service handling. Nothing submitted by plaintiff to the Patent and Trademark Office is corroborated by anything outside the office of the submitting counsel. It was the view of the Commissioner of Patent and Trademarks that these circumstances did not establish the extraordinary conditions that might warrant a waiver.

The decision was for the Commissioner to make, and I cannot find on the basis of the record presented to me that the Commissioner's decision was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law."), aff'd without opinion, 95 F.3d 1166 (Fed. Cir.1996).

² The final rulemaking published on January 20, 1983, at 48 FR 2696-2714 and on February 1, 1983, at 1027 O.G. 9, contains the following comment:

Comment: Two comments were received which proposed that only a certificate of mailing procedure as in § 1.8(a) be used for determining the date of deposit under 35 U.S.C. § 21.

Reply: The filing date of an application is considered to be much more critical than the filing dates of papers accepted under § 1.8(a). The application filing date is often critical for determining if a statutory bar exists, whether foreign priority can be claimed and who is the senior party in an interference. Therefore, papers filed for purposes of receiving an application filing date should have some clear indication of the date of receipt by the United States Postal Service. Such a practice would also probably require storing all of the envelopes in the file wrapper for record purposes.

As explained in the final rulemaking, Express Mail service was found to be preferable because "a readily legible mailing date is provided to both the applicant and the Patent and Trademark Office on the 'Express Mail' label."

procedure by which the timely filing of papers and fees deposited with the U.S. Postal Service may be established *without independent corroboration by an employee of the U.S. Postal Service*. The criticality of an application filing date was considered adequate to justify independent verification by an employee of the U.S. Postal Service of the date of deposit of the application papers with the U.S. Postal Service. Put simply, the insertion by a disinterested employee of the U.S. Postal Service of the date of deposit in the U.S. Postal Service by Express Mail on the Express Mail label of the envelope containing application papers is the *raison d'être* of 37 CFR 1.10.³ Postal employees are presumed to discharge their duties in a proper manner.⁴

While petitioner apparently believes that page 24 was filed on November 7, 2001, the file of application No. 10/045,651 indicates that page 24 was not received, since no such paper is present in the file. The file contains the actual papers received and the file is an official government record prepared and maintained by disinterested USPTO employees as a part of their customary and usual duties. An applicant alleging that a paper was filed in the USPTO and later misplaced has the burden of proving the allegation by a preponderance of the evidence.

The declaration signed by the attorney is dated May 30, 2002. The declaration states that the attorney's customary practice is to count the pages for an application. However, the attorney does not state he personally recalls counting the pages for this specific application which was filed more than six months earlier. To the degree a presumption exists that the attorney correctly followed his customary practices, such a presumption also exists that the Office correctly followed its customary practices. The record fails to discuss whether or not the attorney normally files properly itemized postcard receipts. If yes, then the fact that a deficient postcard was filed for this application would indicate that normal, customary practices were not followed.

Petitioner states that his customary practice included counting the pages and photocopying the papers. Were the papers counted immediately before being placed in the envelope? If not, might page 24 have been lost during the copying process or thereafter?

The petition states, "Applicants submit that the alleged evidentiary standards set forth in the [prior] Decision are irrelevant here." However, the fact remains that the Office does not have the burden of proving what was filed and the date of filing for applications. Instead, the burden of proof remains with petitioner. Petitioner has not established that the application papers received by the Office included page 24.

Petitioner cites a letter from the Office to all practitioners notifying them that the anthrax situation has resulted in delay and damage to some papers. The present issue is whether page 24 was actually received by the Office and is not the condition of the papers when received by the Office or the date the application papers were received. Petitioner has not established that a damaged or undamaged page 24 was received by the Office.

Since applicants have not filed a petition under 37 CFR 1.182 requesting a filing date of May 30, 2002, the date the missing page was filed as the filing date, the page filed on May 30, 2002, will not be entered. The filing date will remain November 7, 2001, and the missing page will not be entered.

³ In promulgating 37 CFR 1.10, the Office also considered other types of mail service (e.g., registered mail and certified mail), but chose the "Express Mail" service since this service provides, *inter alia*, a legible mailing date on the "Express Mail" label for the records of both the applicant and the Office. See "Revision of Patent Procedure," 48 Fed. Reg. at 2697, 1027 Off. Gaz. Pat. Office 12-13.

⁴ Charlson Realty Co. v. United States, 690 F.2d 434, 442 (Ct. Cl. 1967).

An amendment to the specification deleting references to the missing page should be filed prior to the first USPTO action in order to avoid further delays in the examination of the application.

If petitioner desires for the examiner to consider a page which were not submitted as part of the original disclosure, then petitioner may seek to submit some or all of the page as an amendment. Any such amendment will, of course, be reviewed by the examiner for new matter. See MPEP 608.02(a).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

If a request of reconsideration, or petition under 37 CFR 1.182, is not filed within two months, the file will be forwarded to the Office of Initial Patent Examination for further processing with a filing date of November 7, 2001, using only the application papers filed on that date.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.



Charles Steven Brantley
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Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy